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PATENT

#9

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hideki MIYATA

Serial No. 09/879,121

Group Art Unit: 2851

Filed: June 13, 2001

Examiner: Christopher E. Mahoney

For: REAR PROJECTION SCREEN

Certificate of Transmission

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Date

*January 16, 2002*  
*Charles A. Wendel*

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Charles A. Wendel

Typed or printed name of person signing certificate

TERMINAL DISCLAIMERCommissioner for Patents  
Washington, D.C. 20231

Sir:

Your petitioner, DAI NIPPON PRINTING CO., LTD., a  
corporation residing at 1-1, Ichigaya-Kaga-Cho 1-Chome, Shinjuku-

Ku, Tokyo-To, JAPAN, represents that it is the sole assignee of the entire right, title and interest in U.S. Patent Application Serial No. 09/879,121 filed June 13, 2001, as evidenced by an assignment from the inventors of the above-identified patent application. That assignment document (copy attached) was recorded in the U.S. PTO on March 26, 1998, at Reel 9057, Frame 0262 (the Assignment was recorded in parent application Serial No. 09/029,848, filed March 9, 1998, now U.S. Patent No. 6,271,965). Your petitioner, DAI NIPPON PRINTING CO., LTD., hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of U.S. Patent No. 6,271,965, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,271,965, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the above-identified application that would extend to the expiration date of the full

statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned is an attorney of record.

I heraby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

The Commissioner is authorized to charge Deposit Account No. 16-0331 for the required fee in 37 CFR 1.20(d) and for any other fee necessary for consideration of the matter.

Respectfully submitted,

DATE:

January 10, 2002

By

Charles A. Wendel

Charles A. Wendel

Registration No. 24,453

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APPROVED

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## COPIES OF LISTED ITEMS

5. A copy of each listed patent or publication or other item of information in written form, or at least the pertinent portions thereof, is attached.

## SERVICE OF PAPERS

6. (a) p Service of a complete copy of these papers was made by depositing a copy (copies) of these papers with the United States Postal service on , each with sufficient postage as first class mail in an envelope(s) addressed to the following:

Mr. Otto Lee, Esq.  
Intellectual Property Law Group LLP  
Old Bank of America Building  
12 South First Street, 12<sup>th</sup> Floor  
San Jose, California 95113

## ACKNOWLEDGEMENT OF PROTEST BY PTO

- 7.
- x Please acknowledge receipt of this protest by stamping and returning the attached self-addressed postcard.
  - x Please also acknowledge entry of this protest in the reissue application file.

## IDENTIFICATION OF PROTESTOR

Date: January 13, 2004

Fei-Fei Chao, Ph.D.  
(type or print name of protestor)

Fei-Fei Chao  
Signature of Protestor Reg. No.: 43,538

P.O. Box 34385  
P.O. Address

Tel. No.: (202) 344-8011

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**U.S. Patent and Trademark Office  
Commissioner of Patents and Trademarks**

**In re Goldstein**

**Decided September 1, 1988**

**Released August 29, 1990**

**PATENTS**

**1. Practice and procedure in Patent and Trademark Office — Attorneys and agents (§110.07)**

**Practice and procedure in Patent and Trademark Office — Prosecution — Applicants for patent (§110.0917)**

**Title — Assignments (§150.03)**

Attorney's petition to continue as sole representative of patent applicants is denied, since after filing date two of six inventors assigned their interest in application to one company and remaining inventors assigned their interest to second company, since neither assignee alone has sole right to control prosecution of application in that neither assignee owns entire interest in application, and since revocation of petitioner's power of attorney by one assignee therefore bars petitioner from continuing as sole representative of both ownership interests; correspondence with Patent and Trademark Office regarding application must be signed by counsel for both assignees, since 37 CFR 1.33(a) prohibits correspondence with more than one attorney or agent.

Application for patent by six unnamed inventors, filed January 8, 1987. On petition of attorney Jorge A. Goldstein to continue as sole representative of record for application. Denied.

[Editor's note: the names of the inventors and their assignees and the serial number of the application in this case have been withheld by the Patent and Trademark Office.]

Jorge A. Goldstein, of Saidman, Sterne, Kessler & Goldstein, Washington, D.C., for petitioner.

S. Leslie Misrock, of Pennie & Edmonds, New York, N.Y., for parties opposing petition.

Denny, deputy assistant commissioner for patents.

Jorge A. Goldstein, Esq., (hereafter "petitioner") filed on July 6, 1988 a paper entitled REQUEST TO CONTINUE AS REPRESENTATIVE OF RECORD in patent application Serial No. \_\_\_\_\_ filed \_\_\_\_\_. A REVOCATION AND POWER OF ATTORNEY and a RESPONSE TO REQUEST TO CONTINUE AS COUNSEL were filed on July 15, 1988 and July 28, 1988, respectively, by counsel representing an owner of an undivided part interest in the patent application.

The REQUEST is treated as a petition under 37 C.F.R. §1.182. In his cover letter accompanying the REQUEST, petitioner authorized the Commissioner to charge any required fee to Deposit Account No. 19-0036. The petition fee of \$140.00 (see 37 C.F.R. §§1.17(h) and 1.182) is charged to that account.

I conclude, for the reasons given below, that petitioner may not continue as the sole representative of record. The REQUEST is *denied*. The record shows that petitioner alone cannot represent the interests of *all* the named inventors and those deriving title therefrom because the owners of an undivided part interest in the patent application have revoked petitioner's power of attorney and appointed new counsel to represent their interests.

In order to assure that all interests are properly and effectively represented, all further correspondence to the Patent and Trademark Office (PTO) must be signed by petitioner *and* by counsel for the ownership interest which canceled petitioner's power of attorney. Dual correspondence will not be permitted and the PTO will continue to correspond with petitioner, who will remain responsible for coordinating replies or submissions to the PTO.

Petitioner and counsel for the part interest are reminded that the statutory period for response in the patent application expires *September 14, 1988*.

**BACKGROUND**

Patent application Serial No. \_\_\_\_\_ entitled \_\_\_\_\_ was filed in the PTO by petitioner on January 8, 1987 in the names of Inventors A, B, C, D, E and F \_\_\_\_\_. The application was filed without oath. 37 C.F.R. §1.53.

After the filing date \_\_\_\_\_, inventors A and B \_\_\_\_\_ assigned their right, title, and interest in the invention to Company X<sup>1</sup>

<sup>1</sup> The assignment was executed by both inventors on \_\_\_\_\_ and the paper was recorded in the PTO at \_\_\_\_\_ on \_\_\_\_\_.

and the remaining inventors assigned their right, title, and interest in the invention to Company Y.<sup>2</sup> On July 17, 1987 petitioner filed a declaration signed by all the inventors appointing petitioner as their counsel. Petitioner also filed assignments for recordation transferring the appropriate interests of the inventors to Company X and Company Y, which assignments were duly recorded.<sup>3</sup> The record owners, therefore, are Company X and Company Y.

At the time the patent application was prepared, Company X and Company Y were cooperating to develop new products. It appears however that later the previous good feelings between the companies were replaced with hostilities and during this time petitioner concluded that the inventive entity was in error. He concluded that the inventors who assigned their interests to Company Y were not inventors of the claimed subject matter. Company Y and the three inventors who assigned their interests to Company Y disagreed and maintained that all five individuals originally named as inventors are joint inventors here.

Petitioner filed his REQUEST setting out the above-indicated facts and asked for a PTO ruling that he be permitted to remain as attorney of record in the application.<sup>4</sup> Company Y and the three inventors associated therewith filed a revocation of the power of attorney of petitioner and appointed new counsel to represent their interests in the application. The same group also filed a response to the request — through new counsel — and advanced the position that the facts of this case call for dual correspondence with each of counsel for the Company X group (petitioner) and counsel for the Company Y group.

### ANALYSIS

[1] Although A and B \_\_\_\_\_ transferred all of their interests in the application to Company X and C, D and E \_\_\_\_\_ transferred all of their interests in the application to Company Y, the interest of each Company X and Company Y is an undivided part interest in the application. By law, neither of

the assignees is an owner of the entire interest in the application and may not control alone the prosecution of the application. The assignees may agree jointly on a common representative but the facts in this case show conclusively that there is disagreement.

Commissioner Robinson remarked in *Ex parte Harrison*, 1925 C.D. 122, 123 (Comm. Pat. 1924), "Under the [Patent Office] rules the assignee of an entire interest is entitled to control the prosecution of the application, but the assignee of the part interest is not." Since Company Y — as well as Company X — is an assignee of a part interest only in the application, neither assignee has the sole right to control the prosecution. The present rules contain no indication that the philosophy expressed by Commissioner Moore over sixty years ago is not applicable today.<sup>5</sup>

37 C.F.R. §1.32 provides:

The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor.

37 C.F.R. §1.33(a) provides in part appropriate to this ruling:

Amendments and other papers filed in the application must be signed: (1) By the applicant, or (2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or (3) if there is an assignee of record of the entire interest, by such assignee, or (4) by an attorney or agent of record, or (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of [37 C.F.R.] §1.34(a). Double correspondence . . . with more than one attorney or agent . . . will not be undertaken.

In this case, even though the inventors have parted with all of their interests (and therefore have no right to prosecute the application), the ownership interest of each of Company X and Company Y is less than the entire interest in the application. Having less than the entire interest, neither Company X nor Company Y alone may control the case prosecution. The revocation by Company Y of petitioner's power of attorney, therefore, mandates that petitioner may not continue as the sole representative of the ownership interests in this case. Correspondence with

<sup>2</sup> The assignment was executed by all three inventors on \_\_\_\_\_ and recorded in the PTO at \_\_\_\_\_ on \_\_\_\_\_.

<sup>3</sup> See footnotes 1 and 2.

<sup>4</sup> The exhibits accompanying the REQUEST were not relied on for the present determination as none of the documents were signed or bore original signatures of all the indicated signatories.

<sup>5</sup> See also *Ex parte Sandstrom*, 1904 C.D. 486, 487 (Comm. Pat. 1904) where Commissioner Allen observed that "the inventor is permitted to prosecute the case to the exclusion of every one save the assignee of the entire interest." Here, of course, all inventors have assigned their interests to either Company X or Company Y, making Company X and Company Y the joint owners of the application.



the PTO must be signed by counsel for both ownership interests.

The petition is DENIED.

**U.S. Patent and Trademark Office  
Commissioner of Patents and Trademarks**

In re Klein

Decided October 22, 1990

**PATENTS**

**1. Practice and procedure in Patent and Trademark Office — Attorneys and agents (§110.07)**

**JUDICIAL PRACTICE AND PROCEDURE**

**Procedure — Attorney misconduct (§410.34)**

Petition, filed under 37 CFR 10.170, seeking relief from decision suspending attorney from practice before Patent and Trademark Office for two years and placing attorney on probation for five years, is denied, since petition consists solely of arguments by petitioner's counsel and is unsupported by any evidence, and since "hardships" and "devastations" which petitioner claims to have suffered do not constitute "extraordinary situation" warranting relief, especially since any sanction for professional misconduct will likely result in hardship.

Petition filed on behalf of Arthur O. Klein seeking relief from disciplinary action. Petition denied.

Prior decisions: 6 USPQ2d 1528, 6 USPQ2d 1547, 8 USPQ2d 1434, 9 USPQ2d 1558.

William J. Carter, of Carr, Goodson & Lee, Washington, D.C., for petitioner.

Manbeck, commissioner of patents and trademarks.

William J. Carter, Esq., on behalf of Arthur O. Klein (petitioner), filed a petition on September 13, 1990, seeking relief for petitioner under 37 CFR §10.170. Section 10.170 provides for waiver of rules in disci-

plinary matters. Petitions to waive a rule are addressed to the discretion of the Patent and Trademark Office (PTO). *Compare Mobil Oil Corp. v. Dann*, 448 F.Supp 487, 489 n.3, 198 USPQ 347, 349 n.3 (D.D.C. 1978). For the reasons given herein, the petition is denied.

**Background**

At one time, petitioner was registered to practice before PTO. In August of 1984, petitioner was charged with several counts of professional misconduct in a disciplinary proceeding brought under 35 U.S.C. §32 and then 37 CFR §1.348 (1984). Administrative Law Judge Hugh J. Dolan (ALJ) recommended sanctions. *In re Klein*, 6 USPQ2d 1528 (ALJ 1986). Upon consideration of the ALJ's recommendation, then Deputy Commissioner Donald W. Peterson suspended petitioner from practice as an attorney before PTO. *In re Klein*, 6 USPQ2d 1547 (Comm'r Pat. 1987).

The Deputy Commissioner's decision stated the terms of petitioner's suspension, in pertinent part, as follows (6 USPQ2d at 1556):

(1) The period of suspension is seven years;

(2) Execution of the last five years is suspended and petitioner is placed on probation for those five years;

(3) After the first two years and subject to the probationary five-year period, petitioner may be reinstated to practice before the Office in patent cases upon compliance with 37 CFR §10.160;

(4) Petitioner may or may not be required by the Director of Enrollment to take an examination;

(5) No application for readmission shall be considered in less than two (2) years from the effective date of the decision; and

(6) The effective date of the decision is set for thirty days from the decision date or, if appealed and sustained, thirty days following exhaustion of the appeal process.

Petitioner sought judicial review (35 U.S.C. §32), but did not prevail in either the district court or the Federal Circuit. His petition for certiorari was denied. *Klein v. Peterson*, 696 F.Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir.), *cert. denied*, \_\_\_ U.S. \_\_\_, 109 S.Ct. 2432 (1989).

Petitioner's suspension became effective no earlier than March 27, 1989. Thus, under the terms of the Deputy Commissioner's decision, no petition for reinstatement shall be considered before March 27, 1991.

*Louis Milona & Sons, Inc.*, 726 F.2d 734, 741 [220 USPQ 845] (Fed. Cir. 1984). In other words, a court's determination that an accused infringer is entitled to the laches defense only precludes the patentee from obtaining damages for infringement occurring before the suit was brought. In fact, a finding of laches does not completely close the door on damages, as it does not prevent the patentee from recovering damages for any infringement, including use, that may occur between the filing of the suit and the entry of a final verdict.<sup>23</sup>

Thus, it is clear that the effect of a finding of laches on the plaintiff's recovery is limited. Precisely where those limits lie, however, is not so clear. No authority discusses the effect of laches on the future use of units whose sale was insulated from liability. According to the customer defendants, however, the policy of discouraging undue delay that underlies the laches defense supports the application they suggest. While this policy is valid,<sup>24</sup> it is not so strong as to require the result the customer defendants urge here. Laches is, purely and fundamentally, a retrospective defense. See *Adelberg Laboratories, Inc. v. Miles, Inc.*, 921 F.2d 1267, 1272 [17 USPQ2d 1111] (Fed. Cir. 1990) (noting that "defense of laches bars only retrospective relief"); *Hottel*, 833 F.2d at 1573. It is clear that even in the face of the Court's ruling on laches, Odetics can pursue an injunction barring *Storagetek* from using the ATLs in the future. See, e.g., *Aukerman*, 960 F.2d at 1041 (citing *Leinoff*, 726 F.2d 734). And nothing in this record suggests that *Storagetek*'s customers should be treated differently from *Storagetek* in this regard. Moreover, there is no reason in law or policy why Odetics should be precluded from obtaining an injunction against the use of the products by the customer defendants merely because those products left *Storagetek*'s hands before Odetics filed this suit.

<sup>23</sup> Just such a situation is presented here, as *Storagetek* has continued to produce, market, and sell the accused products since this suit was filed, and the customer defendants have continued to use the ATLs they purchased from *Storagetek* earlier. Despite the Court's ruling on laches, Odetics will have the opportunity at trial to recover damages for this alleged infringement.

<sup>24</sup> See, e.g., *Illinois v. Kentucky*, 500 U.S. 380, 388 (1991) (noting that policy behind laches doctrine disfavors untimely assertion of rights); *Mackell v. Casilear*, 137 U.S. 556, 566 (1890) ("The doctrine of laches is based upon grounds of public policy, which require for the peace of society the discouragement of stale demands."); *S.E.R., Jobs for Progress, Inc., v. United States*, 759 F.2d 1, 5 (Fed. Cir. 1985) (same).

In sum, whether Odetics' delay in filing suit against defendants is taken as six years or three, it was clearly unreasonable in the circumstances of this case. Because the delay is inexcusable, and because defendants suffered prejudice from it, this case is an appropriate one in which to apply the doctrine of laches. Odetics is therefore barred from recovering damages from any of these defendants for any infringement occurring before June 29, 1995.

An appropriate Order has already issued.

The Clerk is directed to send copies of this Memorandum Opinion to all counsel of record.

U.S. District Court  
District of Columbia

Baker Hughes Inc. v. Kirk

No. 93-1571

Decided November 8, 1995

JUDICIAL PRACTICE AND  
PROCEDURE

1. Procedure — Judicial review — In general (§410.4601)

Further exhaustion of administrative remedies is not required prior to federal district court's consideration of claim that Patent and Trademark Office exceeded its authority by deciding to consider, without consent of patent assignee, application for reissue filed by co-assignee, since issue of whether PTO has statutory authority to consider reissue application and determine inventorship is legal issue, and court's review will not be aided by further development of factual record, since issue is not one on which agency expertise is required, since PTO has taken definitive position on issue, and since further resort to PTO would thus be futile.

2. Procedure — Judicial review — In general (§410.4601)

Claim that Patent and Trademark Office exceeded its authority by deciding to consider, without consent of patent assignee, application for reissue filed by co-assignee is sufficiently ripe for review, since issue presented is essentially legal, since further factual development at agency level will not help clarify issue, and since PTO has taken final position that it has authority under 35 USC 251 to consider reissue application without co-assignee's consent, and to hold bifurcated proceedings to determine ownership of patent.

## PATENTS

**3. Practice and procedure in Patent and Trademark Office — Reissue — In general (§110.1301)**

Patent and trademark Office exceeded its statutory authority by deciding to consider application for reissue filed by one assignee of patent without consent of second assignee, since decision is contrary to plain language of 35 USC 251, which clearly states that "application for reissue may be made and sworn to by the assignee of the entire interest" in patent, since intent underlying statute is to protect interests of patent holders by requiring that reissue application be filed by assignee of entire interest, since decision cannot be justified in ground that PTO is simply determining whether filing assignee is in fact assignee of entire interest, and since there is nothing in legislative history that contradicts or calls into question clear language of Section 251.

Action by Baker Hughes Inc. against Michael K. Kirk, acting commissioner of patents and trademarks, for determination that Patent and Trademark Office exceeded its authority by deciding to consider, without consent of plaintiff-assignee, application filed by Hydril Co. for reissue of patent no. 4,928,999. On plaintiff's motion for summary judgment, and on defendant's motion to dismiss or for summary judgment. Plaintiff's motion granted; matter remanded to PTO.

Charles D. Tetrault and Alden L. Atkins, of Vinson & Elkins, Washington, D.C.; A.H. Evans and Peter E. Mims, of Vinson & Elkins, Houston, Texas; Carl A. Rowold, of Baker Hughes Inc., Houston, for plaintiff.

Teddy S. Gron, associate solicitor, Nancy J. Linck, solicitor, Fred E. McKelvey, Richard Edward Schafer, Albin F. Drost, Kenneth R. Corsello, and Linda M. Skoro, Patent & Trademark Office, for defendant.

Greene, J.

Plaintiff, Baker Hughes Incorporated, initiated this action against Michael K. Kirk, Acting Commissioner of Patents and Trademarks. Plaintiff alleges that defendant's decision to examine a reissue application for United States Patent No. 4,928,999 (the "'999 Patent") filed by Hydril Company

("Hydril") and to hold proceedings under the reissue application to determine inventorship, without the consent of Baker Hughes, an assignee of record of the patent, exceed the Patent and Trademark Office's ("PTO") statutory authority and should be enjoined. Specifically, plaintiff argues that: defendant's actions exceed his statutory authority and are contrary to law; defendant has abused his discretion and has acted arbitrarily and capriciously and not in accordance with law; and defendant has violated Baker Hughes' due process rights under the Fifth Amendment of the United States Constitution by purporting to decide Baker Hughes' property rights in the '999 Patent in an *ex parte* proceeding.

I  
*Background*

On April 30, 1984, Hydril deposited a patent application for elastomeric guard seal for tubular connections in the PTO. There were three joint inventors named in the application. A declaration of inventorship was signed on April 24, 1984 by first named joint inventor L. Steven Landriault, by second named joint inventor Donald J. Ortloff, and by Landriault for third named joint inventor Charles A. Bollfrass. All three inventors had been working for Hydril at the time that they developed the subject matter of the patent application.

Bollfrass refused to sign the declaration of inventorship that was required to be attached to the application. Hydril and the other two inventors sought, pursuant to 37 C.F.R. § 1.47(a), to have the patent application allowed to proceed without Bollfrass joining in the application. Towards this end, Landriault and two Hydril attorneys filed declarations that Bollfrass was a joint inventor of the subject matter of the patent during his employment at Hydril, and that Bollfrass refused to sign the declaration of inventorship. Landriault declared that he had signed Bollfrass' name to the attached declaration pursuant to 37 C.F.R. 1.47(a).

The PTO allowed the patent application to proceed without Bollfrass' signature. The PTO informed Bollfrass that he was named as joint inventor in the application, that the application had been filed under 37 C.F.R. 1.47(a) and had been granted a filing date of April 30, 1984, and that Bollfrass had the same rights under Rule 47(a) as if he had joined in the inventor's declaration.

On April 30, 1984, the PTO recorded Landriault's and Ortloff's assignments of their interest in the patent to Hydril. On

May 29, 1990 the PTO issued the '999 Patent, which listed Landriault, Ortloff, and Bollfrass as joint inventors, and Hydril as assignee. On June 18, 1992, Bollfrass assigned his interest in the '999 Patent to Baker Hughes, and the PTO recorded the assignment.

During the course of these events, there were two related judicial proceedings. In 1985, Hydril sued Bollfrass and others in Texas state court, alleging that Bollfrass had breached his employment agreement with Hydril. Part of the relief sought by Hydril was that the court order Bollfrass to assign his interest in the Resilient Seal Invention, and any patent applications based on or resulting from that invention to Hydril. *Hydril Company v. Charles A. Bollfrass et al.*, No. 85-45-013, 295th Judicial District, District Court of Harris County, Texas. After a jury trial, a final judgment was entered on January 6, 1992 in favor of Bollfrass.

In 1990, after the '999 Patent had been issued, Hydril sued Baker Hughes and certain of its distributors alleging infringement in an action entitled *Hydril Co. v. Baker Hughes, Inc., et al.*, Civil Action No. H-90-1994 (S.D. Texas) (the "Infringement Action"). Since September 1992, Baker Hughes' summary judgment motion and Hydril's opposition thereto have been pending.

On August 26, 1992, Hydril filed an application with the PTO pursuant to 35 U.S.C. §251 seeking reissue of the '999 Patent to delete Bollfrass as a named inventor.<sup>1</sup> Baker Hughes did not join the application and has not consented to the reissue proceeding.

<sup>1</sup> 35 U.S.C. §251 provides in relevant part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

35 U.S.C. §251 (1988).

On September 17, 1992, the PTO mailed a "notice to file missing parts of application" to Hydril because the application did not satisfy the requirements of 35 U.S.C. §251 for reissue because the application had not been made and sworn to by the apparent assignee of the entire interest in the original patent. According to PTO records both Hydril and Baker Hughes were assignees of interests in the patent. Hydril petitioned the Commissioner to remove the "notice to file missing parts," and to consider the reissue oath in its August 26, 1992 application a sufficient basis on which to proceed with the reissue application. Hydril contended that Bollfrass was not an inventor, and therefore Baker Hughes could have no interest in the patent and is not an assignee.

The Commissioner referred Hydril's petition to the Assistant Commissioner for Patents (the "Assistant Commissioner") for decision. On January 25, 1993, the Assistant Commissioner granted Hydril's petition and vacated the "notice to file missing parts," stating that Hydril, through its submissions, had prima facie shown that Bollfrass was not an inventor, and thus that Baker Hughes has no interest in the '999 Patent. The Assistant Commissioner wrote that his ruling was not a final decision by the PTO that Bollfrass and Baker Hughes have no interest in the '999 Patent, and that the inventorship issue would be decided by the Primary Examiner during examination of the reissue application.

On March 22, 1993, Baker Hughes' petitioned the Commissioner to vacate the January 25, 1993 ruling and reinstate the "notice to file missing parts," arguing that (1) 35 U.S.C. §251 prohibits the Commissioner from considering a reissue application filed by assignees of less than the entire interest in the patent, (2) the issue of an assignee's standing to apply for reissue is not a proper subject of a petition filed under the 37 C.F.R. §1.182 provision dealing with questions not specifically provided for in the regulations; (3) Hydril's claim that Bollfrass had no assignable interest in the '999 Patent merged into the final judgment in the Texas Action and therefore is barred by the doctrines of res judicata and claim preclusion; (4) the Commissioner's decision to resolve Baker Hughes' ownership interest in the '999 Patent in an *ex parte* proceeding violated Baker Hughes' due process rights; and (5) the Commissioner's decision that Hydril had made a prima facie showing that Bollfrass was not an inventor was based on an incomplete and misleading record, and was wrong

Docket No.

YIP0032-US

# Declaration and Power of Attorney For Patent Application

## English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**CARBURIZATION TREATMENT METHOD AND CARBURIZATION TREATMENT APPARATUS**

the specification of which

(check one)

☒ is attached hereto.

☐ was filed on \_\_\_\_\_ as United States Application No. or PCT International

Application Number \_\_\_\_\_

and was amended on \_\_\_\_\_

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

2001-169635

JAPAN

05 JUNE 2001

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

I hereby claim the benefit under 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, C. F. R., Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Status)  
(patented, pending, abandoned)

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Status)  
(patented, pending, abandoned)

\_\_\_\_\_  
(Application Serial No.)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Status)  
(patented, pending, abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

10107449-032302

**POWER OF ATTORNEY:** As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. *(list name and registration number)*

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